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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/315,822 05/21/99 CHRISTENSEN

S SELL-0008

TM02/0409  
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EXAMINER

JANVIER, J

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

04/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/315,822

Applicant(s)

CHRISTENSEN, SCOTT N.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 475.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The abstract of the invention is too long (over 25 lines). A new abstract is required that is clearly indicative of the invention to which the claims are directed. No new matter can be introduced. Further, on page 52, lines 3 and 5, "or the like" was used. It renders the abstract confusing, vague and indefinite. Therefore, "or the like" cannot be used in the abstract.

Appropriate correction is required.

On page 52, line 3, "on conjunction" should apparently be --in conjunction--.

On page 52, line 24, "to generated" should apparently be --to generate--.

The instant Application claims priority date from Application 08/630,330, filed on April 10, 1996, now U.S Patent 6,035, 280. The Application is reminded to update the Cross-Reference section of the current application with the above information since reference was made to Application 06/630,330, not to a U.S Patent.

The "Declaration of Oath" is missing. A replacement is required.

Finally, there is not enough support for an in-store kiosk that can be used by a remote user to access his or her Virtual Coupon account stored in SELECTSOFT Database Computer 801 of fig. 8. In-store computer kiosks were briefly introduced as an option on page 33 and lines 28-32. The Examiner assumes that the Applicant believes that in-store kiosks are so well known in the art that a proper disclosure was not necessary. Although there is no 112(1)

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issue here, a proper disclosure would have helped the Examiner, especially when the current claims are directed to in-store kiosks.

Although the applicant stated that the IDS was sent with a related application - 09/323,240, the Examiner never received it. Therefore, only U.S Patents and PCT initialized on the PTO Form 1449 were considered. Copies of Foreign and NPL references are requested. Further, related application 09/323,240 is not a parent continuation.

### ***Claim Objections***

Claim 4 is objected to because of the following informalities:

As per claim 4, line 6, "is deemed" should apparently be --is redeemed--. Appropriate correction is requested.

### ***Claim Rejections - 35 USC § 102(e)***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8 receive priority date from application 08/630,330, filed on April 10, 1996, now U.S Patent 6,035, 280.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Powell, US Patent 5,887,271, filed on Feb 20, 1996.

The applied reference, based upon its earlier effective U.S. filing date, constitutes a prior art under 35 U.S.C. 102(e).

As per claims 1, 2, 3, 6, 7 and 8, Powell teaches a system comprising:

1. A computer kiosk 1710 of fig. 10 arranged for generating coupons, said kiosk 1710 comprising:

Means (network cables, modems and phone lines 180 of fig. 1) for accessing a database (within computer network 1020 of fig. 1); said database including a list of consumer names, consumer identification data and virtual coupon data corresponding to each consumer name (col. 4, 1<sup>st</sup> paragraph- fig. 1);

A data entry means (keyboard, magnetic stripe reader and portable card 285 of fig. 4B) for entering consumer identification data **encoded on portable card 285** for consumer 280 of fig. 4B using said kiosk (1710) of fig. 10;

First generating means for printing ( printer 1718 –col. 5, 5<sup>th</sup> paragraph) a coupon, in response to a command input by consumer 280 of fig. 4B, based upon said virtual coupon data corresponding to said consumer identification data **encoded on portable card 285 of fig.4B and**

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stored in the database within **Computer Network 1020 of fig. 1** of said consumer 280 using said computer kiosk 1710; and

Processing means (such as Central Financial Computer 911 with appropriate Hardware and Software of fig. 20), coupled to said database, for receiving a request by said consumer 280 using said kiosk 1710 **or preferably checkout station 903 connected to Central Financial Computer 911 over Network 912 of fig. 20 using program 922 of fig. 12** for redemption of a selected virtual coupon corresponding to said consumer identification data **encoded on consumer card 285**, and for generating redemption data indicating said selected virtual coupon has been redeemed.

2. Wherein said means for accessing **the computer kiosk** comprises a keyboard.(clearly anticipated or inherent).
3. Wherein said means for accessing further comprises means (network cables or modems, phone lines ) for transmitting data to and from (among checkout stations 900 and 903, kiosk 1710, Research Center and homes 1025) a remote computer network 1020 of fig. 1 or 912 of fig. 20.
6. Wherein said processing means (checkout stands 900 and 903 of figs. 12 and 20 using program 922 as described in column 10 and lines 55-65) retrieves virtual coupon data from said remote database.
7. Wherein said data entry means comprises a computer diskette or consumer cards **215, 225**

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**235, 245, 255, 265, 275, 285, 295 and 315 carried by respective consumers 210, 220, 230, 240, 250, 260, 270, 280, 290 and 310 (col. 7, 3<sup>rd</sup> paragraph)**

8. Wherein said computer diskette **or consumer card 315** of fig. 4B contains data **or a Virtual Coupon list 8435 of fig. 15B stored in consumer card 315 memory 8460** downloaded (col. 2, lines 21-36) from said remote computer network entered on said computer diskette prior to use of said computer kiosk 1710 of fig. 10.

As per claims 4 and 5, Powell teaches a system further comprising:

4. Wherein said processing means comprises means **such as checkout station 900 having a CPU 950, a long term storage medium 925, Random Access Memory 920 and a POS Computer Program 922 encoded on storage medium 925, when executed on the computer 900 acts to detect a product scanned by UPC reader 910 to determine a reference price for the scanned product, search for the product identification in the memory 8460 of consumer card 315 and deduct a discount from the reference price if the product is identified in the consumer card memory 8460 (col. 10, lines 51-65). It is further understood that counting the number of times consumer 310 redeemed a particular virtual coupon, and fraud indication means for indicating fraud if the number of times a virtual coupon is redeemed by the consumer exceeds a predetermined amount can be accomplished in real time using Powell's system. Since the virtual coupon list 8435 is encoded in the consumer card 315 memory 8460, for example, preventing a consumer from redeeming a coupon more than a predetermined number of**

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times allowed is easily achieved. Upon reading consumer card 315 memory 8460 at checkout 900, the card data is compared to the customer's profile stored in the remote database within the computer network 1020, thereby making sure that the information read from consumer card 315 memory 8460 is accurate and consistent with the data that was remotely downloaded from the database within the Computer Network 1020 of fig. 1 by consumer 310 using PC 2000 over phone line 180 of fig. 1 and encode on consumer card 315 using device 2415 attached to PC 2000 (col. 4, lines 21-36). By so doing, fraud can virtually be eliminated.

5. Wherein the consumer identification data is imprinted on a selected coupon or **encoded on a portable card 285 having** a bar code **thereon** (see abstract).

### Conclusion

Although, U.S Patents 5,970,469 to Scroggie, 5,708,782 to Larson et Al, 5,502, 636 to Clarke and 5, 353, 218 to De Lapa et Al are not used in this Office Action, they are considered as relevant prior. Applicant is further directed to consult these references.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner




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by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 305-3900.

3/23/01

  
ERIC W. STAMBER  
PRIMARY EXAMINER